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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,352	03/26/2001	Akihiro Tozaki	Q63622	6361

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,352

Applicant(s)

TOZAKI ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Newly submitted claims 9-16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 1-8 are directed to hybrid recording medium, classified in class 375, subclass 275.3. Claims 9-16 are directed to a system and method for updating information which utilizes an inconsistency detecting controller and inconsistency detecting method steps, classified in class 714, subclass 48. The two groups are distinct species of invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 8: Claim 8 is a newly added claim which includes a "table of contents pointing to a latest version of a pre-recorded file". The last line of claim 8 also refers to updating to updating the pointing information. While the original disclosure does refer to a table of contents (called "VTOC") in pages 9-12, there is no apparent suggestion that the VTOC contain pointers

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to the latest version of a file, or that the pointer or pointer or pointing information in that table be updated in any way. Accordingly, these two features are found to be new matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tognazzini (U.S. Patent 6,600,713).

Claim 1: Tognazzini discloses a compact disk having read only areas (101) and read/write areas (102, 103). The read/write areas (102, 103) may include updates to the permanently stored information on the read only area (col. 5, lines 11-14).

Claim 2: A serial number may further be recorded on the disk (col. 5, lines 48-60) and readable as “file management information”. The serial number uniquely identifies the disk (col. 5, line 56), and thus serves as “volume configuration information”. The serial number also identifies user input information (col. 6, lines 20-27), and thus also reads as “file configuration information”.

Claim 4: Col. 4, line 60 through col. 5, line 3 describe the system as an optical disk having at least two recordable surfaces. The read/write surface exists on two of the surfaces.

Claim 5: The optical disk includes read only surfaces and read/write surfaces, both of which are irradiated by a laser beam (col. 4, line 60 through col. 5, line 3).

Claim 6: FIG. 3 discloses a controller which is readable as a server, and a CPU which is readable as a “server information acquisition section”. The read heads are the “hybrid

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information acquisition section". The file management information is the serial number recorded on the read/write portion of the disk. The computer program described at col. 6, lines 21-28 read as a file information comparator and file acquisition section since this program compares the serial number read by the read heads and acquires records and control information based on the serial number. The file write heads read as the "file write section" and file re-writing section" since they are capable of writing and re-writing files based on specific user actions or inputs.

Claim 7: See remarks for claim 2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini (U.S. Patent 6,600,713) in view of Official Notice.

Claim 3: Tognazzini teaches that the read only area may contain multiple files, such as music files, but not a single file.

However, the Examiner takes Official Notice that the skilled artisan would readily recognize that a compact disk may contain any number of files, from zero files, one file, two files, or hundreds of files, depending upon the physical limitations of the disk. Accordingly, it would have been obvious to one of ordinary skill in the art to modify Tognazzini to include only a single file (such as a single song) in the read area as a user desired option which is readily recognizable by the person of ordinary skill in the art. A single file can be a "file portion" (an entire portion of the file).

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Remarks

Applicant's arguments have been considered.

Applicant's arguments are primarily directed to the amended version of claim 1, calling for the storage of an updated version of the file in the write area. Examiner finds that Tognazzini does in fact teach this feature at col. 5, lines 11-14.

This office action is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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